

Application No.: 10/615,809

Attorney Docket No. A-817 (US)

**REMARKS****The Restriction Requirement**

The Examiner has set forth a "scope of the invention" based on Applicants' election of species. The Examiner's self-determined "scope of the invention" limits the case to compounds where

- R is  $-(CH_2)_1-R^3$ ; and
- $R^3$  is "a 6 membered ring with ring members consisting of only carbon and nitrogen, optionally unsaturated as defined" (Office Action at page 3, lines 1-3).

Applicants respectfully submit that the Examiner's limitation of  $R^3$  is not consistent with the language of the claims at issue. Specifically, the words "**6 membered ring with ring members consisting of only carbon and nitrogen...**" appear nowhere in the specification or claims, and their insertion into the claims raises potential issues of new matter.

At a minimum, Applicants are entitled to a limitation of  $R^3$  that speaks in the same terms of that originally contained in the specification and claims. In this case, Applicants have used the term: "**substituted or unsubstituted 5-6 membered heterocyclyl...**" and Applicants submit that the use of these terms is more appropriate than the language that has been constructed, Ex parte, by the Examiner.

**The Claim Objections**

The Examiner has objected to claims 1-12, 16-19, 23-27, 29-30, 32, 34 and 36 for containing non-elected subject matter. Applicants have obviated the rejection by amending the claims to:

- limit R to  $-(CH_2)_1-R^3$ ; and
- limit  $R^3$  to "substituted or unsubstituted 5-6 membered heterocyclyl"

Applicant's request that the Examiner withdraw the objections.

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**The Rejections under 35 USC § 102****Lockemann et al.**

The Examiner has rejected Claim 1 under §102(b) as being anticipated by Lockemann et al. (*Chemische Berichte* 1947, 485-493). Applicants respectfully submit that the rejection is improper on the basis that the cited species within Lockemann does not even fall within the "scope of invention" set forth by the Examiner. Specifically, the Examiner has limited the scope of R<sup>3</sup> to be **"6 membered ring with ring members *consisting of only carbon and nitrogen...*"**, yet the cited compound has a phenyl in the R<sup>3</sup> position. Phenyl does not read on the Examiner's definition.

Applicants request that the Examiner withdraw the rejection.

**Huth et al.**

The Examiner has rejected Claims 1-2, 8, 10-12, 16-17, 19, 23-25, 29 and 36 under §102(b) as being anticipated by Huth et al. (WO 00/27819). To support the rejection, the Examiner cites a compound where R<sup>1</sup> is 3-pyridyl. The Examiner has further rejected Claims 1-4, 10-12, 16-17, 19, 23-25, 29 and 36 under §102(b) as being anticipated by the same reference, Huth et al. (WO 00/27819). To support the rejection the Examiner cites a compound where R<sup>1</sup> is a 1,2,3,4-tetrahydroquinolyl.

Applicants submit that they have obviated the above rejections by amending Claims 1 and 2 to limit the definition of R<sup>1</sup> to the specific species set forth in Original Claim 4 (minus 1,2,3,4,tetrahydroquinolyl). Claim 4 has been accordingly cancelled.

Applicants respectfully request that the rejections under Section 102(b) be withdrawn.

**The Rejection Under 35 USC § 103**

The Examiner has rejected Claims 1-12, 16-17, 19, 23-25, 29-30, 32, 34 and 36 under §103(a) as being unpatentable over Altmann et al. (USPN 6,448,277). To support the rejection, the Examiner points out that Altman teaches compounds where R<sup>1</sup> is aryl, and R<sup>2</sup> (equivalent to Applicants' "R") is pyridyl. From this, the Examiner concludes that it would have been obvious to "follow the synthetic scheme of Altman et al to make the claimed invention with a reasonable expectation of success." (Office

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Action at page 8, lines 18-19). Applicants respectfully submit that the Examiner has failed to make a prima facie case of obviousness.

The Examiner has failed to point to any suggestion in the art that would prompt a person of ordinary skill in the art to substitute Altmann's R<sup>1</sup> aryl, with Applicants' R<sup>1</sup> heterocyclyl. Indeed, as currently amended, the definition of R<sup>1</sup> has been further limited to the specific species of heterocyclyl groups contained in original claim 4 (minus 1,2,3,4,tetrahydroquinolyl). None of these specific species of heterocyclyl groups is disclosed or suggested by Altmann. Accordingly, a prima facie case of obviousness has not been made out by the Examiner.

Applicants respectfully request that the Examiner withdraw the obviousness rejection..

#### **The Obviousness-Type Double Patenting Rejection**

The Examiner has rejected claims 1-12, 16-17, 19, 23-25, 29-30, 32, 34 and 36 on the grounds of obviousness-type double patenting as being unpatenable over claims 1 and 7 of Altmann et al. (USPN 6,448,277). Applicants submit that since the claimed invention is not obvious in view of Altmann—as explained previously—the rejection is improperly supported.

Moreover, as explained in the MPEP:

Before consideration can be given to the issue of double patenting, two or more patents or applications must have at least one common inventor and/or be either commonly assigned/owned or non-commonly assigned/owned but subject to a joint research agreement...  
MPEP § 804 (emphasis added).

None of the prerequisite criteria apply to the instant application and the cited reference, and therefore Applicants submit that the rejection is improper.

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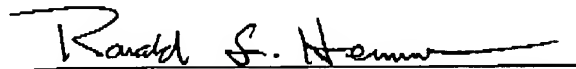
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**CONCLUSION**

Applicants submit that the rejections of record have been overcome by the above Amendments and Remarks, and request that the case be passed to allowance. Kindly forward correspondence regarding this case to the address below. (change of address attached)

Respectfully submitted,

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